



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,038	07/12/2001	Robert A. MacDonald	KEY1025US	1936

7590

11/19/2003

Terry L. Wiles
Popovich & Wiles, PA
IDS Center, Suite 1902
80 South 8th Street
Minneapolis, MN 55402-2111

EXAMINER

YIP, WINNIE S

ART UNIT	PAPER NUMBER
----------	--------------

3637

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,038

Applicant(s)

MACDONALD ET AL.

Examiner

Winnie Yip

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 34 is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-33 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Part II DETAILED ACTION

This office action is in response to applicant's amendment filed on July 24, 2003.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections

1. Claim 35 is objected to because of the recited sub combination feature “the blocks in the upper course being connected to blocks in the lower course by pins extending from a top surface of the blocks in the lower course by pins extending from a top surface of the blocks in the lower course and received by a pin receiving cavity formed in the bottom surface of the blocks in the upper course” (lines 3-6) are confusing whether or not the block includes a pin and pin receiving cavity in the upper and lower surface as recited in the preamble since claim 35 only claims “a wall block” but not a wall. Due to the confusion, the claim 35 is being treated as a combination on the merits. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 13 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Blomquist et al. (US Patent No. 6,488,448).

Blomquist et al. show and teach a wall block for use in forming a retaining wall inherently having front and rear faces, the wall block (i.e., Fig. 10) comprising a block body including spaced apart and parallel upper and lower surfaces (106, 104), the distance between the upper and lower surfaces defining a thickness of the block, opposed and substantially parallel first and second faces (100, 102), opposed and non-parallel side surfaces (108, 110), wherein the first face (100) has an area greater than the second face (102), one of the surface (104) having three channels (114, 118, 120) extended substantially parallel to the first and second faces (100, 102), another surfaces (106) having a pin (130) which includes a head portion (136) extending outwardly from the surface of the block said other two channels are used to receive a horizontal reinforcement member as claimed, one or both of the first and second surfaces (100, 102) (see col. 5, lines 17-18; col. 8, lines 13-16) or a side surface (see col. 5, lines 43-44) may be textured in a manner resulting in the appearance of nature stone, wherein the block is capably front-and- rear surfaces reversibly positioned in the courses to construct a wall having the front surface being formed form the first faces of some of the blocks and the second faces of some of the other blocks as recited in claim 1, and the block is capably up-and-down reversibly positioned in the courses such that the lower surface of the blocks in the upper courses having the channels respectively functioning a pin receiving cavity for receiving a pin projected form the upper surface of the block in the lower course with respect to the front and rear faces of the wall as recited in claim 35.

4. Claims 13 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Ciccarello (US Patent No.5,984,589).

Ciccarello shows and teaches a wall block (10) for forming a wall from multiple wall blocks and the wall having a front surface and a rear surface, the wall block (10) comprising a block body including spaced apart and parallel an upper surface (12) and a lower surfaces (11), the distance between the upper and lower surfaces defining a thickness of the block, opposed and substantially parallel first front and second rear faces (13, 14), the first front face (13) having an area greater than the second face (14), and opposed and non-parallel side surfaces (15, 15'), wherein the lower surface (11) has at least two channels (18, 18') extending substantially parallel to the front and rear faces (13, 14) and transversely cross opposite side surfaces (15, 15') such that the block may have the lower surface formed with the channels for receiving reinforcing rods as claimed, at least one of the front or rear surfaces is textured in a manner resulting in the appearance of nature stone, the wall block is capable to be reversibly placed in the courses for construction of a wall having a front surface of the wall formed of the first front faces of a portion of the multiple wall blocks and the second faces of others of the multiple wall blocks as claimed, and the channels in the lower surface of the block, when positioned in the upper course, functioning as a pin receiving cavity for receiving the pin (17) projected form the upper surface of the blocks in the lower course as claimed.

Claim Rejections - 35 USC § 103

5. Claims 1-14, 16- 33, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacDonald (US Patent No. 6,149,352) in view of Blomquist et al. '448.

MacDonald teaches a retaining wall comprising upper and lower courses, each course comprising a plurality of first, second, and third blocks (42, 44, 46) having different widths, each block having an upper and lower surfaces (8,10) to define a block thickness, opposed and substantially parallel first and second faces (12, 14), the first face having an area greater than the second face such that opposed side surfaces (16,18) are non-parallel to each other, the first or second faces being textured in a manner resulting in the appearance of nature stone, each block having at least one core (20) and apertures (22a-f) extending through the upper and lower surfaces of the block, the lower surface of the block having a channel (73), a pin (80) having a body portion (78) being fitted in one of the aperture on the upper surface of the block on the lower course and a head portion (76) extending upwardly and being inserted into the channel (73) on the lower surface of the block of upper course for retaining and stacking the blocks of upper course on the blocks of the lower course (see col.10, lines 57-62), wherein the first and second blocks (42, 46) each having the two side surface being converged and the one of first and second faces (12) having an area greater than the area of other first and second faces (14), the third block having the first side surface (16) being substantially perpendicular to the first and second faces (12, 14) and the second side surface (18) being substantially non-perpendicular to the first and second faces, wherein the blocks being positioned in the courses such that the wall includes a straight section and a corner section oriented in a manner to form a 90 degree angle (see Fig. 2), and the front surface of the wall includes the first faces (the larger area) of some of the plurality of first or second blocks and the second faces (the smaller area) of the other plurality of first or second blocks. Although, MacDonald does not define the block having at least two channels extending passed through the lower surface and substantially or parallel to the

Art Unit: 3637

first and second faces functioning to receive the pin with respect to the position of the blocks to be placed to form the front and rear surfaces of the wall. Blomquist et al. teaches a retaining wall comprising a plurality of blocks (18, 20), each block (i.e., 20) textured front and rear surfaces and having three channels (114, 118, 120) formed on one of the upper and lower surfaces such that one of corresponding channels functioning as a pin receiving cavity reversibly for receiving a pin (130) projected from an other surface of the block in the lower course to form the retaining wall and other may used to receive a reinforcement member therethrough. It would have been obvious to one ordinary skill in the art at the time the invention was made to modify the wall of MacDonald having blocks having the lower surface formed with at least two or three channels as taught by Blomquist et al. for selectively receiving a pin projected on an upper surface of the block in the lower course or receiving a reinforcement member therethrough with respect to the orientation of the front and rear surfaces of the block as claimed for forming a wall having some first surfaces of the blocks and some rear surfaces of the blocks being stacked one over another and reinforced on the upper and lower courses as claimed.

Allowable Subject Matter

6. Claims 15 and 34 are allowed.

Response to Arguments

7. In response to applicant's argument that, regard to the rejection to claim 13 Ciccarello '589 fails to teach and suggest a block can be oriented in a manner as claimed by claim 13 which recites " the block body is configured for construction of a wall having a front surface formed by

Art Unit: 3637

different faces of the blocks, it is not deemed persuasive because, first anticipation is established when a single prior art reference discloses, expressly or under principles of inherence, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). In the case, applicant only claims "a block". *Ciccarello* teaches "a block" including all elements as claimed except does not define the block can be used in different orientations to from a wall as claimed. However, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, application only positively recites a block but not a wall, *Ciccarello* clearly teaches a wall block having a configuration as claimed such as includes a front face (13) having a size greater than the size of a rear face (14), non-parallel side surfaces, two channels (18, 18') parallel to the front and rear surface. Therefore, the block of *Ciccarello* is capable to be reversibly positioned to form a wall having a front surface formed by the front face of some of the block and the rear face of other block as claimed. Therefore, the rejection is deemed proper.

8. Applicant's arguments with respect to claims 1-14, 16-33, 35-37 have been considered but are moot in view of the new ground(s) of rejection.

Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



Winnie Yip
Primary Examiner
Art Unit 3637

wsy
November 3, 2003